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10/643,074	08/19/2003	Robert L. Alcorn	072575-0048	3054
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MCDERMOTT, WILL & EMERY			EXAMINER	
11682 EL CAMINO REAL			NGUYEN, PHILLIP H	
SUITE 400				
SAN DIEGO, CA 92130-2047			ART UNIT	PAPER NUMBER
			2191	
			NOTIFICATION DATE	DELIVERY MODE
			05/29/2009	ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

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SIP\_Docket@mwe.com

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	10/643,074	ALCORN ET AL.
	<b>Examiner</b> Philip H. Nguyen	<b>Art Unit</b> 2191

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If no period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### **Status**

1) Responsive to communication(s) filed on 27 March 2009.  
 2a) This action is FINAL.      2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### **Disposition of Claims**

4) Claim(s) 1-16 is/are pending in the application.  
 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_\_ is/are allowed.  
 6) Claim(s) 1-16 is/are rejected.  
 7) Claim(s) \_\_\_\_\_ is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### **Application Papers**

9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### **Priority under 35 U.S.C. § 119**

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### **Attachment(s)**

1) Notice of References Cited (PTO-892)  
 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)  
 3) Information Disclosure Statement(s) (PTO/SSE/08)  
 Paper No(s)/Mail Date \_\_\_\_\_

4) Interview Summary (PTO-413)  
 Paper No(s)/Mail Date \_\_\_\_\_  
 5) Notice of Informal Patent Application  
 6) Other: \_\_\_\_\_

#### **DETAILED ACTION**

1. This action is in response to the amendment filed in 3/27/2009.
2. Claims 1-16 remain pending in this application with claim 7 amended.

##### ***Response to Amendment***

3. Prior objection to the specification for introducing new matter is hereby withdrawn in view of applicants' drawings and specification.
4. Prior rejection to claims 13-16 under 35 U.S.C 112, first paragraph for failing to comply with the written description requirement is hereby withdrawn in view of applicants' drawings and specification.
5. Prior rejection to claims 7, 8, and 13-16 under 35 U.S.C 101 non-statutory is hereby maintained in view of applicants' amendment.

##### ***Response to Arguments***

6. Applicant's arguments with respect to claims 1-16 have been considered but are moot in view of the new ground(s) of rejection.

##### **Applicants argue**

- a) Claim 7 recites subject matter (i.e. a computer) under 35 U.S.C 101.
- b) Claim 13 is not limited to software per se.
- c) Helmick fails to teach "invoking an enhance system functionality by using a modified user interface or a plug-in manager (i.e. API) configured to add new functionality to an extensible education system"

##### **Examiner respectfully disagrees:**

- a) Although claim 7 has been amended to recite "a computer" however this computer is not necessarily part of the extensible educational system. Applicants are respectfully suggested to amend claim 7 to recite for example "An extensible educational system comprising: a computer."
- b) Although claim 13 recites "a computer-readable medium" however the specification provides intrinsic evidence that the computer-readable medium is intended to cover signals, such are currently not patentable.
- c) Helmick does not explicitly teach a plug-in manager (i.e. API) configured to add new functionality to an extensible education system. However, the on-line educational system in Helmick allows instructors and/or user to post or share educational contents on the web browser (see at least col. 19:51-55). In other words, the user interfaces in FIGS. 3A-3X are the modified user interface. Therefore, Helmick inherently teaches a plug-in manager configured to add new functionality to the on-line educational system. For clarification purposes, examiner issues a new ground of rejection based on a new prior art.

***Claim Rejections - 35 USC § 101***

7. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

8. Claims 7, 8, and 13-16 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claim 7 recites a system but it appears reasonable to interpret this system by one of ordinary skill in the art as software per se. Applicants' specification provides no

explicit and deliberate definition of the components ("a user interface", "a plug-in manager", and "an authentication user interface") that make up the system other than they are software components, which directed to functional descriptive material, *per se*, and are therefore non-statutory. Claim 8 directly depends on claim 7 and therefore suffers the same deficiency.

Claim 13 recite a computer-readable medium, which is disclosed in the specification to cover signals (see page 3 of the specification), such are currently not patentable. Claims 14-16 directly or indirectly depend on claim 13 and therefore suffer the same deficiency.

***Claim Rejections - 35 USC § 103***

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 1-5 and 7-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Helmick et al. (U.S. Patent No. 6,470,171, hereinafter Helmick), in view of Gupta et al. (U.S. Patent No. 6,484,156, hereinafter Gupta).

As per claim 1:

Helmick teaches

installing on a server a file compatible with a known system application program (see at least col. 7:39-41 **"Server 36 stores a database structure in secondary storage 50, for example, for storing and maintaining information**

**for on-line educational courses"), wherein the installed file utilizes the application program to provide a modified user interface to at least one user of the system (see at least col. 7:45-47 "Processor 52 may execute one or more applications 44 in order to provide the functions shown in the flow charts of FIGS. 1A-1M and to provide the web pages (i.e. modified user interface) shown in the screens of FIGS. 3A-3X");**

invoking an enhanced system functionality by using the modified user interface (see at least **FIGS. 3A-3X** – Note: instructors and users using these web browser (i.e. *modified user interface*) for on-line education);

specifying in the file one or more roles of a user that can utilize the enhanced system functionality (see at least **FIGS. 2A-2R**);

determining if the user has rights to utilize the enhanced system functionality based on the role of the user (see at least col. 10:5-8 "The system determines if the log-on is from an instructor or from a user, which may be determined by comparing information in the log-on request with information the database identifying authorized users and instructors. If an instructor logs on, the system displays an instructor view of a course home page such as home page screen 800. Otherwise, the system displays a user view of a course home page such as home page screen 842"); and

if the user has rights, granting access to the user to utilize the enhanced system functionality (see at least col. 10:20-24 "If the instructor or user is permitted access, the system displays an electronic syllabus in syllabus

**section 806 for a selected educational course and also displays an indication of content concerning educational materials for the course").**

Helmick does not explicit teach

using Application Programming Interface (API) to provide a modified user interface.

However, Gupta teaches

using Application Programming Interface (API) to provide a modified user interface (see at least col. 6:39-44 **"Annotation server 10 includes a**

**Multimedia Annotation Web Server (MAWS) module 130, which is an Internet Services Application Programming Interface (ISAPI) plug-in for Internet Information Server (IIS) module 135. Together, these two modules provide the web server functionality of annotation server 10".**

Therefore, it would have been obvious to one having an ordinary skill in the art at the time the invention was made to modify Helmick to incorporate the teaching of Gupta to use ISAPI plug-in (i.e. plug-in manager) for providing functionality of the server. The modification would have been obvious because it would provide web server functionality of the server.

As per claim 2:

Helmick further teaches

storing the one or more roles into a system data repository (see at least **FIGS. 2A-2R).**

As per claim 3:

Helmick further teaches

wherein the enhanced system functionality is provided by at least one of a hyperlink and an icon (see at least **FIGS. 3A-3X**).

As per claims 4, 10 and 14:

Helmick further teaches

wherein the one or more roles comprise at least one of user administrator, course administrator, system support, observer, support, portal administrator, system administrator, instructor, student and teacher's assistant (see at least **FIGS. 2A-2R**).

As per claim 5:

Helmick further teaches

denying access to the enhanced system functionality if the user does not have access rights (see at least col. 10:19-20 “**If access is not permitted, the system may display an error message**”).

As per claims 7, 9 and 13:

Helmick further teaches

a user interface (see at least **FIGS. 3A-3X**); and  
an authentication user interface configured to verify a role of a user in the extensible educational system, and grant or deny a user access to the new functionality based on the role of the user in the extensible educational system, wherein the role of a user comprises at least one of: user administrator, course administrator, system support, observer, support, portal administrator, system

administrator, instructor, student and teacher's assistant (see at least col. 10:1-25 "the system receives a log-on request by a user. The log-on request may include, for example, a user's or instructor's name or other identifying information along with an optional password. The system determines if the log-on is from an instructor or from a user, which may be determined by comparing information in the log-on request with information the database identifying authorized users and instructors...The system determines if the instructor user is permitted access to the on-line educational system. If access is not permitted, the system may display an error message. Otherwise, if the instructor or user is permitted access, the system displays an electronic syllabus in syllabus section 806 for a selected educational course and also materials for the course").

Helmick does not explicitly teach

a plug-in manager configured to add new functionality to the extensible education system.

However, Gupta teaches

using Application Programming Interface (API) to provide a modified user interface (see at least col. 6:39-44 "Annotation server 10 includes a Multimedia Annotation Web Server (MAWS) module 130, which is an Internet Services Application Programming Interface (ISAPI) plug-in (*i.e.* plug-in manager) for Internet Information Server (IIS) module 135. Together,

**these two modules provide the web server functionality of annotation server 10").**

Therefore, it would have been obvious to one having an ordinary skill in the art at the time the invention was made to modify Helmick to incorporate the teaching of Gupta to use ISAPI plug-in (*i.e. plug-in manager*) for providing functionality of the server. The modification would have been obvious because it would provide web server functionality of the server.

As per claims 8, 11 and 15:

Helmick further teaches

wherein the plug-in manager and the authentication user interface are invoked using the user interface (see at least *FIGS. 3A-3X*).

As per claims 12 and 16:

Helmick further teaches

wherein the user interface is displayed by installing one or more files on a server (see at least *FIGS. 3A-3X*).

11. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Helmick et al. (USPN 6,470,171), in view of Gupta et al. (U.S. Patent No. 6,484,156, hereinafter Gupta).

As per claim 6:

Helmick does not explicitly teach

wherein the file is installed on the server by using a Java Archive file.

However, official notice is taken that the file is installed on the server by using a Java Archive file is well known in the art at the time the invention was made to compress plurality of files into one compressed file.

Therefore, one would have been motivated to store/install the file using Java Archive File because it provides security (e.g., a JAR file can be digitally signed enabling users to verify the signature and then grant the program security privileges), decreased download time (e.g., since the JAR file is compressed, it takes less time to download than it would have to download each individual file), portability (e.g., all Java Runtime Environments know how to handle Jar files), etc.

***Correspondence Information***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Phillip H. Nguyen whose telephone number is (571) 270-1070. The examiner can normally be reached on Monday - Thursday 10:00 AM - 3:00 PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wei Y. Zhen can be reached on (571) 272-3708. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

PN  
5/19/2009  
/Wei Y Zhen/  
Supervisory Patent Examiner, Art Unit 2191